

REMARKS

Claims 21-23, 25-29 and 35-36 are pending in this application. Claims 26 and 27 have been amended to better delineate the scope of the claims. In the Office Action dated February 16, 2006, claim 28 was rejected under 35 U.S.C. §112, ¶2 as indefinite based on the use of the term “multibag.” Claims 28 and 29 has been amended to use the term “multi-bag” as spelled in the specification. With respect to the term, the Examiner’s attention is drawn to ¶ 14 (p. 5) of the specification:

According to a preferred form of the invention, the multi-bag comprises a series of flexible walled bags disposed side by side such that mouths of the bags face a common direction and form a row, giving the multi-bag a generally rectangular shape when unfilled and stretched to a taut condition.

One such multibag is illustrated in Figure 2 and described in ¶ 30 of the specification. The Examiner’s attention is also drawn to MPEP 2173.02 which provides:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a *reasonable degree* of particularity and distinctness. ... The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. (emphasis

supplied).

Applicant respectfully submits that one of ordinary skill in the art would have no difficulty understanding “multi-bag” in view of the specification. As amended, claims 28 and 29 are believed to fully comply with the requirements of §112 insofar as one of ordinary skill in the

art would have no difficulty in determining the scope of the term.

Claims 21-23, 25-29, 35 and 36 were rejected under 35 U.S.C. §103(a) as unpatentable over Maroney et al., U.S. Patent No. 4,720,048 in view of D'Elia U.S. Patent No. 5,000,325. The Office Action stated that "there are no recitations in the instant claims that would inhibit Maroney et al. '048 from functioning as a 'mail delivery system' as called for in the claims of the instant invention." However, the rejection is based on alleged obviousness, not anticipation, and the issue is whether Maroney et al. may properly be combined with D'Elia. For the reasons set forth below, Applicant submits that the references are not properly combined and that the pending claims are allowable.

Maroney et al. discloses a cart for transporting sensitive electronic devices and components including a bin formed from a material which has an outer conductive layer to provide a Faraday shielded container and an inner conductive layer or, alternatively, a static dissipative layer which is conductive of a controlled rate to offer a slow, more controlled bleed of static electricity. (See, col. 1, lines 10-13, col. 2, lines 17-24). The bin is provided with parallel tracks ... [that] receive a folder [50] bent back upon itself which forms a carrier for one electronic module being transported by the transport vehicle or cart. The ends of the folder have downwardly extending projections [46] which are received in spaced relation within the J-shaped tracks on each side of the bin so that they can be supported in the bin and, in turn, receive one of the electronic printed circuit boards or modules between the folded halves. (col. 2, lines 42-53).

The Maroney et al reference addresses the problem of avoiding damage to sensitive electronic components caused by electrostatic discharges during transport of the components. (See, col. 1, lines 14-34, col. 2, lines 25-41). Nowhere does Maroney et al. suggest or disclose

that the folders 50 (col. 5, line 65 - col. 6, line 11, Figure 2) are part of a mail delivery system, suitable for a mail delivery system or suitable for receiving mail pieces therein. The problems involved in designing a transport for sensitive electronic components are completely different than the factors involved in designing a mail delivery system. Consequently, one of skill in the art would not look to Maroney et al. as a starting point for a mail delivery system. In view of the differences between the two endeavors, it is not surprising that there is no suggestion or disclosure that would support a combination of Maroney et al. with D'Elia.

Maroney et al., directed to a device for transporting sensitive electronic components, is not pertinent to a mail delivery system. *See* MPEP §2141.01(In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.)(citations omitted). Maroney et al. is classified in U.S. Class 280 for land vehicles and subclass 47.34 for stable, hand-propelled vehicles. One of skill in the art would not look to transport devices for electronic components nor to land vehicles as a starting point for a mail delivery system.

D'Elia describes a sorting rack for mail, the rack having a plurality of vertically-spaced, horizontally extending elements. A plurality of bags are removably supported on the horizontally extending elements for receiving mail therein. In contrast to Maroney et al. wherein the folders 50 are vertically oriented, D'Elia teaches that the bags should be oriented horizontally. (Abstract, Figures 4-6, col. 3, lines 4-9, col. 5, lines 10-15).

The Office Action relied on the D'Elia reference as teaching side walls united by a bottom wall. However, the bags of the D'Elia will not function in the Maroney et al. device

because the bags of D'Elia do not have the downwardly extending appendage 46 required to hang folders 50 on tracks 42 of the bin of Maroney et al. One of skill in the art would readily recognize that the bags of D'Elia would not work in the Maroney et al. device. This is also not surprising since the folders of Maroney et al. are designed to be hung vertically while the bags of D'Elia are designed to be stretched over loops 12 in a horizontal configuration.

Further, the folders 50 of Maroney et al. would not function in the rack 1 of D'Elia. D'Elia describes mounting the bags horizontally in the rack in two different ways. The first is described at col. 3, lines 59-65:

In order to releasably mount a bag member B on the rack, the opposite loops 25 of the bag member are manually held and engaged over the projecting elements 12 so that the loops are stretched and the bag member is held with its mouth 23 stretched open and facing forwardly on the rack. Each bag member rests on a respective shelf 8.

Folders 50 of Maroney et al. could not be retained on the loop members 12 of the D'Elia rack as described above since the folders do not have loops 25 or equivalent structure.

The second method is described at col. 4, lines 46-55:

In order to mount the bags on the rack, the bag is fitted over a pair of horizontally aligned loop members 12' so that the bag is held in stretched condition with its mouth 32 open at the front of the rack. The loop members 12' are of a length to extend sufficiently deeply into the respective bag member to support the bag members in horizontal attitude and hold their mouth portion open. In this way the wire loop members 12' serve as the means for supporting the bag members and for holding the mouth portions thereof open.

Since the folders 50 of Maroney et al. are open on three sides (Figure 2), one of ordinary skill would immediately recognize that the folders could not be fitted over and held in a stretched condition on loop members 12' as taught by D'Elia.

Since the folders of Maroney et al will not function in the rack of D'Elia and since the bags of D'Elia will not function in the cart of Maroney et al., it is submitted that there is no

motivation or suggestion for the proposed combination. MPEP §2143.01 (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”)

The Office Action suggested that it would have been obvious to have fabricated the devices of Maroney et al. with sidewalls united by a bottom wall as taught by D’Elia for “increased support and stability of articles placed therein.” However, there is nothing in the record that indicates that there is any need for such a modification. Folders 50 of Maroney et al. are each designed for transporting a single electronic component in the bin disclosed therein. (*See*, col. 5, line 68 - col. 6, line 2, “disposed between the folded over portions of folder 50 is one of electronic printed circuit boards”). There is no evidence of record that folders 50 are in any way deficient for that purpose or that any additional “support or stability” is required. One of skill in the art would not modify the folders of Maroney et al. as suggested absent a real reason for making the modification.

The Office Action also suggested that it would have been obvious to use the system of Maroney et al. for holding and sorting mail pieces as taught by D’Elia to “thereby increasing the storage use and capability of the system.” However, as far as can be determined from the references, it appears D’Elia’s device has greater capacity and capability (for sorting mail) than the cart of Maroney et al. This is not at all surprising since D’Elia apparatus was designed for sorting mail, whereas the cart of Maroney et al. was designed to transport sensitive electronic components. Thus, the purported motivation (increased capacity and capability) is not supported based upon the art of record or any other objective evidence of record.

In view of the foregoing, Applicant submits that there is no evidence of record that

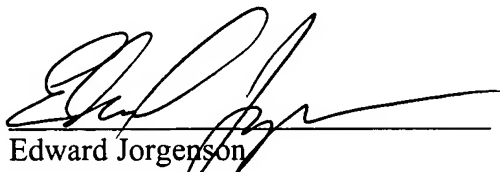
supports the combination of Maroney et al. and D'Elia.¹ Consequently, Applicant respectfully submits that the §103(a) rejection of the pending claims should be withdrawn.

Applicant has made an earnest effort to place the case in condition for allowance.

Favorable action is respectfully requested.

It is believed that no additional fees are due. However, if this is incorrect, please charge any additional fee to Deposit Account No. 50-1588.

Respectfully submitted,



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¹ The Federal Circuit requires a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The factual inquiry whether to combine references must be thorough and searching. In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). It must be based on objective evidence of record. The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").